

**REMARKS**

Claims 1-23 are pending in this application.

Claims 4 and 12 are cancelled.

Claims 1-3, 5-11, and 13-23 are rejected.

The office action dated August 7, 2008 indicates that claims 1-3, 5-11, and 13-23 are rejected under 35 USC 102(b) as being anticipated by Csipkes U.S. Patent No. 6,188,402.

The Background of the present application discusses the selection of tools used to perform manufacturing operations. Consider the example of a tool operator who typically receives a build plan from manufacturing engineering and tool information from a tooling group. The build plan and tool information might identify a tool, but they do not identify the tool version. Different versions of a tool might be available.

The task of deciding upon the proper tool version is delegated to the tool operator. The tool operator performs research and decides upon the proper tool version.

The present application, in contrast, describes systems and methods that shift the decision-making away from the tool operator. Tool information, including a tool version, is provided in a build plan. Thus, the tool operator doesn't have to perform research to decide upon the proper version.

The '402 patent does not teach or suggest a system that provides a tool version to a tool operator. The '402 patent describes a system for assembling and testing a product. A computer is used to display assembly instructions to an assembler (col. 4, lines 50+). The assembler performs the assembly manually, and the computer then performs testing (col. 5, lines 6+). Figures 6a-6b illustrate screens of instructions for the assembly of an inductor to a PC board. Figures 5a-5c illustrate test result screens (col.2, lines 33-34).

These screens are silent about tool versions. The rest of the '402 patent is silent about tool versions. The task of selecting the proper tools appears to be delegated to the assembler, the very thing that the present application avoids.

Applicants' attorney Hugh Gortler called Examiner Hartman and left a message, asking him to pinpoint where the '402 patent discusses different tool versions, and how the correct tool version is selected. Examiner Hartman responded by leaving a message with applicants' attorney. In his message, Examiner Hartman did not pinpoint a passage in the '402 patent. However, he expressed concern that the terms "tools" and "tool version" are so broad as to encompass anything. He indicated that claims reciting "drills" would remove the overbreadth issue. Examiner Hartman is thanked for leaving the message.

New claim 24 and amended claim 17 address the Examiner's concerns. Instead of reciting drills, however, these claims recite "machine tools." New claim 24 and amended claim 17 recite a plurality of tools for performing machining operations, at least some of the tools having different variations for performing the same machining operation. These claims also recite a build plan that selects tool variations for those tools having different variations. Advantageously, the tool operator doesn't have to perform research to decide upon the proper version.

The '402 patent is silent about tools for performing machining operations (e.g., drills). The '402 patent is also silent about a build plan that selects tool variations for those tools having different variations. Therefore, claims 17-19 and 24-25 should be allowed over the '402 patent.

Still, we respectfully disagree with the '102 rejection. The '402 patent does not support the examiner's argument about selecting tools and tool versions. The '402 patent is silent about tools and tool versions.

The system of claim 1, which has been amended for clarity, recites a system that provides the proper tool version to the tool operator. Amended claim 1 recites a first means for selecting a build plan in response to entered product information, the build plan including tool information and a tool version selected from a plurality of tool versions; and second means for outputting the selected build plan to a tool operator. Thus, the tool operator doesn't have to perform research to decide upon the proper version.

The '402 patent doesn't teach or suggest such a build plan. Therefore, claim 1 and its dependent claims 2-3 and 5-8 should be allowed over the '402 patent.

Base claim 9 also recites build plans that specify tool versions (it too has been amended for clarity). For the reasons above, claim 9 and its dependent claims 10-11 and 13-15 should also be allowed over the '402 patent.

The office action also raises a double patenting rejection over claims 1-2, 4-5, 7, 12-13 and 15-16 of assignee's U.S. Patent No. 7,212,882. The office action indicates that this rejection may be overcome by the filing of a terminal disclaimer. A terminal disclaimer will be considered after allowable subject matter has been indicated. At this time, however, the filing of a terminal disclaimer is premature since the claims might still be changed.

The Examiner is encouraged to contact the undersigned to discuss any remaining issues prior to mailing another office action.

Respectfully submitted,

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